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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/665,029 | 09/16/2003 | William Waycott | 20612.002/P30632US01 | 4492 |

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| EXAMINER |
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ROBINSON, KEITH O NEAL

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| ART UNIT | PAPER NUMBER |
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1638

DATE MAILED: 09/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/665,029

Applicant(s)

WAYCOTT, WILLIAM

Examiner

Keith O. Robinson, Ph.D.

Art Unit

1638

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 23 August 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☒ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). filed May 20, 2004
13. ☐ Other: _____.

Continuation of 11. does NOT place the application in condition for allowance because: Applicant argues that they have satisfied the test for written description by providing a structural feature, namely characteristics that distinguish members of the claimed genera from non-members (see page 8, 1st paragraph of 'Remarks' filed August 23, 2006). The Examiner would like to correct Applicant's statement on page 7, 4th paragraph of 'Remarks' filed August 23, 2006, wherein Applicant states, "the Examiner acknowledges that the specification discloses numerous physiological characteristics of the iceberg lettuce cultivars". The Examiner was not "acknowledging" but simply quoting the statement from the specification and explaining that this statement is not an adequate written description (see page 3, 4th paragraph to page 4 end of 1st paragraph of the Office Action mailed May 19, 2006). As stated in the previous Office Action mailed May 19, 2006, the claims are broadly drawn to any and all lettuce plants having the claimed length to width ratio and color ranges.

Applicant argues that F1 hybrid *Lactuca sativa* L. plants meet the written description requirement and that the person of ordinary skill in the art would be aware of the numerous lettuce varieties that can be used in breeding programs with an iceberg lettuce cultivar of PSR 6425 (see page 9, 2nd paragraph of 'Remarks' filed August 23, 2006). This is not persuasive. As stated in the previous Office Action mailed May 19, 2006, hybrids are produced by crossing at least two different parents and if one is not adequately described the hybrid itself cannot be adequately described (see page 5, 2nd paragraph).

Applicant argues that a deposit statement will be provided upon an indication that the subject matter is otherwise allowable (see page 10, 3rd paragraph of 'Remarks' filed August 23, 2006). This is not persuasive. As stated in the previous Office Action mailed May 19, 2006, the deposit information is incomplete (see page 6, 1st paragraph).

Applicant argues that the specification is enabling for an iceberg lettuce as claimed (see page 10, last paragraph to page 11, lines 1-2 of 'Remarks' filed August 23, 2006). This is not persuasive. The Examiner repeats the arguments of the Office Action mailed August 25, 2005 (see pages 10-11) and the Office Action mailed May 19, 2006 (see pages 6, 3rd paragraph), in short, that the claims are broadly drawn to the broad genus of iceberg lettuce plants with the claimed characteristics, that description of breeding methods alone does not enable one skilled in the art to make and use the claimed invention and that there is undue trial and error experimentation for one skilled in the art to produce the claimed invention.

Applicant argues that the skilled artisan would be able to obtain F1 hybrids based on the specification (see page 11, last paragraph to page 12, end of 1st paragraph of 'Remarks' filed August 23, 2006). This is not persuasive. As stated in the previous Office Action mailed May 19, 2006, one skilled in the art would not know be able to use the claimed hybrids without guidance as to the second parent (see page 7, 2nd paragraph).

Applicant argues that there is no nexus between the cited references relating to corn breeding with iceberg lettuce breeding programs (see page 12, 2nd paragraph of 'Remarks' filed August 23, 2006). This is not persuasive. As stated in the previous Office Action mailed May 19, 2006, the references were cited to show the unpredictability in the field of plant breeding and that breeding for specific characteristics depends on many factors beyond the breeder's control (see page 7, 4th paragraph). Applicant's arguments with regard to the Examiner's reliance on the statements in the specification are persuasive (see page 13, 2nd paragraph of 'Remarks' filed August 23, 2006); however, these arguments do not overcome the other issues discussed with regards to lack of enablement. Applicant's arguments with regard to the Ryder et al reference to support epistatic interactions in lettuce breeding are persuasive (see 13, 3rd paragraph of 'Remarks' filed August 23, 2006); however, these arguments do not overcome the other issues discussed with regards to lack of enablement.

Applicant argues that the cited reference does not disclose or suggest an F1 hybrid *Lactuca sativa* or iceberg lettuce plants having one or more parents from the line PSR 6425, PSR 6595 or PSR 6032 (see page 14, 5th paragraph of 'Remarks' filed August 23, 2006). This is not persuasive. As stated in the previous Office Action mailed May 19, 2006, the claimed hybrids read on any lettuce plant; therefore, the cited reference is not improper (see page 8, last paragraph).

DAVID H. KRUSE, PH.D.
PRIMARY EXAMINER

